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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,779	07/27/2001	Ronald J. Skrzyniarz	1945.BDM	8792

7590 01/21/2005

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EXAMINER

CHANG, VICTOR S

ART UNIT PAPER NUMBER

1771

DATE MAILED: 01/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/916,779	Applicant(s) SKRZYNIARZ ET AL.	
	Examiner Victor S Chang	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-22 is/are pending in the application.
- 4a) Of the above claim(s) 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-18, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/8/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Introduction

1. The Examiner has carefully considered Applicants' remarks filed on 11/8/2004.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.

Rejections Based on Prior Art

4. Claims 12-18, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy et al. (US 4036673), generally as set forth in section 6 of Office action dated 5/5/2004, together with the following response to argument.

First, the Examiner repeats the relied upon prior art by Murphy as follows: Murphy's invention is directed to a method for installing (bonding) a sheet of surface covering material on a substrate surface by a foamed adhesive (column 1, lines 7-12). Murphy teaches that it is known art to install (bond) a surface covering material on a surface such as a floor surface, countertop, etc. (column 1, lines 16-18). Particularly suitable adhesives including polyvinyl acetate latex, etc. may be used to form the foamed adhesive (column 3, lines 51-68).

With respect to Applicants' argument "There is no disclosure in Murphy that would lead the skilled artisan to the claimed invention let alone provide any indication that such could be successfully accomplished. Murphy fails to suggest and does not

Art Unit: 1771

provide any motivation to use foamed adhesive as claimed by applicants to bond a wood composite core material to a high pressure laminate. Murphy's enabling disclosure and claims are directed to applying a surface covering to a floor surface. Murphy fails to provide teachings suggestive of a reasonable expectation of success. Murphy fails to teach or suggest all the claimed limitation" (Remarks, page 6, top paragraph), the Examiner repeats (see Office action dated 5/5/2004, pages 3-4, bridging paragraph) that Murphy expressly indicated that installing floor covering is just a typical example for bonding a sheet of surface covering material on a substrate surface (column 3, lines 20-21), and Murphy's teaching of installing a sheet of surface covering to a substrate clearly encompasses the making of a countertop, which is taught by Murphy as a known analogous art, as set forth above. As such, in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art of installing (bonding) a sheet of surface covering material to use a foamed polyvinyl acetate adhesive to install a countertop (high pressure laminate) to a substrate of particle board (wood composite), as taught by Murphy, motivated by the desire to use a quicker and easier method to obtain an improved bonded article, such as a smooth even finished surface (column 2, lines 37-62; and column 3, lines 33-50), and with a reasonable expectation of success, Applicants' argument to the contrary notwithstanding.

With respect to Applicants' argument "The examiner refers to, but does not apply U.S. Patent 3,891,788 (Karszes) ... Karszes merely discloses end use applications of various high pressure laminates bonded to a backer material such as particle board ...

Art Unit: 1771

While Karszes discloses examples of cheaper adhesives (... white glues such as polyvinyl acetate ...), there is no acknowledgement that a polyvinyl acetate emulsion is recognized in the art for bonding such materials and nothing to indicate that is known and accepted in the art" (Remarks, pages 6-7, bridging paragraph), the Examiner notes that Karszes reference is merely cited as an evidence that white glue polyvinyl acetate (i.e., emulsion of polyvinyl acetate) is a suitable type of adhesive for bonding various high pressure laminates (countertop) to a substrate such as a particle board (wood composite) (column 2, lines 15-27). Since the primary reference Murphy has already expressly taught that foamed polyvinyl acetate emulsion is a suitable adhesive for installing (bonding) a sheet of surface covering material on a substrate surface, as set forth above, it is the Examiner's position that there is no requirement to incorporate Karszes as secondary reference in the title of rejection.

With respect to Applicants' request that "Should the examiner continue to rely on the Karszes disclosure, it is requested that the examiner make this document of record by listing it on a form PTO-892 ..." (Remarks, page 7, last paragraph), the Examiner apologizes that a PTO-892 for Karszes reference was advertently not included in the prior Office action dated 5/5/2004. However, since the U.S. Patent No. 3,891,788 of the Karszes reference has been clearly identified in the Office action, and Applicants apparently have fully understood the disclosure by Karszes, it is believed that the analysis set forth in the previous Office Action is proper, and that the aforementioned error has caused no harm to the Applicants. Nevertheless, a PTO-892 for the Karszes reference is attached to this Office action.

Conclusion

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1771

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VS
Victor S Chang
Examiner
Art Unit 1771

1/12/2005

Elizabeth M Cole
ELIZABETH M COLE
Patent Examiner